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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,433	12/12/2003	Maurizio Della Cuna	1011-599	4601
47888	7590	08/01/2006	EXAMINER	
HEDMAN & COSTIGAN P.C. 1185 AVENUE OF THE AMERICAS NEW YORK, NY 10036			HARDEE, JOHN R	
			ART UNIT	PAPER NUMBER

1751

DATE MAILED: 08/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/734,433

Applicant(s)

CUNA ET AL.

Examiner

John R. Hardee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-49 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 26-49 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 26-49 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the specific species recited in the claims, does not reasonably provide enablement for the entire genres recited in the claims. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims. The claims are of the form (e.g., claim 27) "surface active agents such as octyl acid, glycerin, hydroxy phenyl trichloro and hydroxy phenyl dichloro ethers." Does this mean that some surfactant must be present, does it mean that one of octyl acid, glycerin, hydroxy phenyl trichloro and hydroxy phenyl dichloro ethers must be present, or does it mean, as written, that octyl acid, glycerin, hydroxy phenyl trichloro and hydroxy phenyl dichloro ethers must be present? In the first case, the applicant does not have sufficient basis for reciting any and all surfactants, assuming that antioxidants are what are intended, the second is misleading and should be replaced by accepted Markush language, and the third appears to be more restrictive than applicant intended. Thus the claims have scope of enablement problems (112, 1st para.), they are

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indefinite (112, 2nd. para.) or they do not claim what applicant intends to claim. Further enablement and indefiniteness problems arise because none of these materials is surface active.

Regarding claim 41, it is not clear that undecanol has basis in the genus of acids recited in the specification.

Claim 26 recites an agent to be added to a washing base, and subsequently recites that the washing base is present in the material that is to be added to the washing base. A number of dependent claims further modify the washing base, which is not otherwise described. These claims do not further modify the parent claim, which recites a cleansing and aiding agent; alternatively, something else was meant by the recitation, making the scope of the claims indefinite.

Where applicant recites language such as "such as" (claims 27 and 28, at least) or puts some limitations in parentheses (claims 43 and 44, at least), do those additional limitations further limit the claim, or are they superfluous?

4. Claims 26-49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Reasons are given in the rejection above. In addition, the claims are rife with spelling and terminology errors. Claims 23-25 should be amended to recite that the numbers in the second column are weight percentages, assuming that is what is meant. What is a weight rate?. Several claims recite trademarks, rather than ingredients. This is indefinite because a trademark only

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indicates a source of goods, and because applicant provides no guidance regarding what materials are intended by these trademarks, applicant's protestations to the contrary. What are TEO, mea and tea, dymethyl and distiril? What is hydroxy phenyl trichloro?

A number of the claims do not end in periods, raising questions about whether some part of the claim text was omitted.

In claim 33, "said glycol ester" lacks antecedent basis, and the depicted ester is not a glycol ester.

Parts of claims 39 and 40 are missing.

Claims 47-49 do not appear to further modify claim 26, as they do not comprise alpha- and beta-hydroxyesters. What is a quaternized tert amine? An amine is either quaternized or it is tertiary. What does 'tert' mean?

These are exemplary. Once again, applicant is strongly urged to have the specification and claims rewritten by a chemist with native proficiency in English. Applicant is again cautioned to refrain from adding new matter.

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 26-49, *to the best of the examiner's ability to understand them*, are rejected under 35 U.S.C. 103(a) as being unpatentable over Vermeer, US 5,880,076.

The reference discloses detergent and personal care compositions comprising

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glycacarbamate and glycaurea compounds (abstract). Regarding claim 26, lactic acid esters are disclosed as useful emulsifiers at col. 30, lines 34-35. No specific amount is disclosed, but determination of the emollient-effective amount of a disclosed emollient is well within the abilities of the person of ordinary skill in the surfactant art. A number of zinc salts are disclosed at the top of col. 38. Regarding claim 3, several specific fragrances are disclosed at col. 38, line 56. Regarding claims 27-29, sequestrants are disclosed at col. 21, line 54, silicates at col. 42, lines 51+ and aluminosilicates (zeolites) at col. 42, lines 60+. Addition of vitamin E (tocopherol) is disclosed at col. 31, line 67. Antiperspirants are disclosed at col. 37, lines 26+. Addition of 8-18 carbon alcohols is disclosed at col. 30, lines 10+. Addition of EDTA is disclosed at col. 33, line 5. Suitable surfactants are disclosed at col. 22, line 45-col. 27, line 63. This reference differs from the claimed subject matter in that it does not disclose a composition which reads on applicant's claims with sufficient specificity to constitute anticipation.

It would have been obvious at the time the invention was made to make such a composition, because this reference teaches that all of the ingredients recited by applicants are suitable for inclusion in a surfactant composition. The person of ordinary skill in the surfactant art would expect the recited compositions to have properties similar to those compositions which are exemplified, absent a showing to the contrary.

In the case where the claimed ranges overlap or lie inside ranges disclosed by the prior art, a *prima facie* case of obviousness exists. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed Cir. 1990).

Response to Arguments

7. Applicant's arguments filed June 16, 2006 have been fully considered but they are not persuasive. Applicant's arguments are drawn to the intended use of the Vermeer compositions as opposed to those of the presently recited compositions. Recitation of intended use is afforded little or no patentable weight during prosecution.

Claims 47-49 contain the trademark/trade names Cosmacol ELI and Isalchem

11. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe undefined ingredients of a washing base and, accordingly, the identification/description is indefinite.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to the examiner, Dr. John R. Hardee, whose telephone number is (571) 272-1318. The examiner can normally be reached on Monday through Friday from 8:00 until 4:30. In the event that the examiner is not available, his supervisor, Mr. Douglas McGinty, may be reached at (571) 272-1029.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "J. Hardee", with a stylized, cursive script.

John R. Hardee

Primary Examiner

July 27, 2006